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APPLICATION NO. 08/733,072	FILING DATE 10/16/96	FIRST NAMED INVENTOR MAKOUTI	ATTORNEY DOCKET NO. K 0286-1156
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EXAMINER YAN, R	
ART UNIT 2854	PAPER NUMBER

DATE MAILED: 08/18/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/733,072

Applicant(s)

Makoui et al.

Examiner

Ren Yan

Group Art Unit

2854



☒ Responsive to communication(s) filed on Jul 27, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12, 18-22, 25-30, 33-43, 49-63, and 68-72 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-12, 18-22, 25-30, 33-43, 49-63, and 68-72 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, 18-21, 33-43, 49-63 and 68-72, drawn to an embossing roll or system with specific structure on removably mounting an embossing sleeve on a roller core using pressurized air to facilitate the operation, classified in class 101, subclass 382.1.
- II. Claims 22 and 25-30, drawn to a method of forming an embossing roll using a three dimensional laser engraving device, classified in class 101, subclass 483.

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as chemical etching or machining. Additionally, the process as claimed can be used to make a materially different embossing roll which does not require the use of pressurized air to mount its sleeve.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and different field of search, restriction for examination purposes as indicated is proper.


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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren Yan whose telephone number is (703) 308-0978. The examiner can normally be reached on weekdays from 9:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed. Burr, can be reached on (703) 308-0979. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2864.


Ren Yan
Primary Examiner
Art Unit 2854

Ren Yan
Aug. 10, 1998